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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,352	12/21/2000	Niels Mache	10628-004	2352

20583 7590 11/05/2004

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,352

Applicant(s)

MACHE ET AL

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. A telephone call was made to Att. Bruce Barker (Reg. No. 33,291) on 11/01/04 to request an oral election to the above restriction requirement, but did not result in an election being made because the applicant could not be contacted at the telephone number on the record.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I claims 1-19 are drawn to a property exchange management system and a corresponding method (computer software and an Internet platform) for managing a property exchange which comprises exchanging flow of information among at least one broker, at least one property exchanger as a client and at least one qualified intermediary connected via a multi-user data communication network. This group of inventions has at least one distinct feature not present or required in the inventions of groups II-IV such as a communication of information by means

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of the multi-user data communication network amongst the parties involved.

Group II claims 20-26 are drawn to a method (computer software and an Internet platform) for automatic detection of like-kind exchanges. This group of inventions has at least one distinct feature not present or required in the inventions of groups I and III such as selecting combinations of the property owner's pool of acquired and disposed assets.

Group III claims 27-29 are drawn to an optimization method (computer software and an Internet platform) for asset selection in like kind exchanges with adjustable parameters to meet needs of specific users. This group of inventions has at least one distinct feature not present or required in the inventions of groups II and I such as minimizing potential profit deferral that is allowed to be utilized after a predefined time period.

3. The inventions are distinct, each from the other because of the following reasons:

The inventions are distinct if it can be shown that either:
(1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus

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as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case, the process as claimed in method of invention II can be practiced by another materially different apparatus than that recited in I. For example, method recited in invention II would require a materially different apparatus which performs process of selecting combinations of property owner's pool of acquired and disposed assets and matching the assets for a like kind exchange. Similarly, it can be shown that the apparatus of invention I can be used to perform a materially different process than that recited in invention II, for example, controlling the flow of information among at least one broker application, at least one property exchanger and at least one qualified intermediary using a multi-user data network.

Likewise, the process as claimed in method of invention III can be practiced by another materially different apparatus than that recited in I. For example, method recited in invention III would require a materially different apparatus which performs process of maximizing deferrals of taxable income and minimizing bounded cash in a qualified intermediary account. Similarly, it can be shown that the apparatus of invention I can be used to perform a materially different process than that recited in

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invention III, for example, controlling the flow of information among at least one broker application, at least one property exchanger and at least one qualified intermediary using a multi-user data network.

Method claims of inventions I, III and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as controlling the flow of information among at least one broker application, at least one property exchanger and at least one qualified intermediary using a multi-user data network, Invention II has separate utility such as selecting combinations of property owner's pool of acquired and disposed assets and matching the assets for a like kind exchange and Invention III has separate utility such as maximizing deferrals of taxable income and minimizing bounded cash in a qualified intermediary account.

See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 11/1/04
Jagdish N. Patel

(Primary Examiner, AU 3624)

11/01/2004